

U.S. Patent Application No. 10/591,108
Response to Restriction Requirement dated September 2, 2008
Reply to Office Action of July 31, 2008

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REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

At pages 3-5 of the Office Action, the Examiner has requested that the applicant elect from one of ten groups, identified as Groups I-X, respectively. The Examiner states that due to the numerous variables in the claims (Z, R¹, R², R³, R⁴, R⁵, R⁶, R⁷, X, etc.) and their widely divergent meanings, a precise listing of inventive groups cannot be made. The groups listed by the Examiner are indicated to be exemplary. Also, at page 6 of the Office Action, the Examiner states that if applicant is unable to elect a single invention, the applicant may instead choose to elect a specific compound and the Examiner will attempt to group it.

To be responsive, the applicants elect, with traverse, Group I, directed to claims 1-34, drawn to a compound of formula I wherein Z is phenyl or naphthyl wherein Z is optionally substituted as defined in claim 1 excluding groups containing heterocycle groups; R¹ and R⁴ are as defined in claim 1; R² and R⁵ are as defined in claim 1; R⁶ is H or C₁₋₄ alkyl; and R⁷ is alkylphenyl as seen, for example, in Example 70.

For the following reasons, the restriction requirement is respectfully traversed.

The International Searching Authority and International Preliminary Examining Authority did not find lack of unity with the claimed subject matter. As explained in M.P.E.P. §1893.03(d), examiners are reminded that unity of invention (not restriction practice pursuant to 37 CFR 1.141 - 1.146) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371. Thus, there is no reason why the Examiner cannot also find the same unity since the same or similar standards apply. Thus, all claims in all of the

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groups should be examined at this time. In addition, with regard to the non-elected claims, it also is respectfully submitted that these claims should be examined at this time since there appears to be no serious burden on the part of the Examiner to search the entire scope of the claims from the standpoint that the searches would overlap (MPEP §803). At a minimum, these claims should be rejoined upon the allowability of the subject matter of Group I due to their relationship to the subject matter of Group I.

In traversing this restriction requirement, the applicants particularly point out that the classification of Groups I to V has been based on five (5) different meanings of the radical R⁷ namely wherein R⁷ represents an alkylphenyl, alkylpyridyl, alkylbenzimidazole, alkylisothiazole or alkylpyrimidinyl. These groups are considered exemplary by the Examiner. The Examiner further states that the compounds vary in classification and, when taken as a whole, result in vastly different compounds. However, according to the Examiner, an alkylbenzimidazole and an alkylisothiazole (Groups III and IV) are both classified in Class 548. Therefore, it does not appear that different search criteria are required for both groups. Moreover, Example 46 of the present application does not have an alkylbenzimidazole group, but an alkylphenyl group as the radical R⁷. In fact, none of the examples shows an alkylbenzimidazole group at said position. Also, Example 140 shows an alkylpyrazole group instead of an alkylisothiazole group as stated by the Examiner. Again, none of the examples has an alkylisothiazole group at the respective position. Finally, Example 66 (see Group V) has an alkyl pyrazine moiety but not an alkylpyrimidine moiety. Therefore, the classification of the Examiner is not justified as it appears to be based on incorrect chemical classifications.

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As indicated, the applicants have made an election in response to the restriction requirement. However, the applicants also request that the Examiner reconsider the basis of the restriction requirement in that the applicants propose a new group definition for the restriction requirement based on the examples of the present application. As regards the limitations in view of the radical Z, the applicants accept the proposal of the Examiner. The same applies to the radicals R¹ to R⁶. However, with respect to radical R⁷, the applicants suggest the following definition be used for the restriction requirement: R⁷ is C₀-C₄ alkylene connected to an optionally substituted ring system wherein the ring system comprises a saturated, unsaturated or aromatic mono or bicyclic carbocycle or heterocycle wherein the heterocycle contains up to 4 heteroatoms selected from the group consisting of sulfur (including SO and SO₂) oxygen and nitrogen (including =N(O)). In view of the document cited by the Examiner, namely WO 2005/040095, the compounds of this new proposed selection in fact contribute over the alleged prior art since said alleged prior art requires the presence of a second carbonyl functionality which is not present in the compounds defined above.

Finally, on page 2 of the Office Action the Examiner states that in view of different claim categories in the same International Application, specific rules have to be followed, for examples, as laid down under Rule 13 PCT. Therein it is stated that in addition to an independent claim for a given product, an independent claim for a process especially adapted for the manufacture of the said product and an independent claim for use of said product may be present in one application. Therefore, the applicants respectfully submit that a method of treatment claims, viz., present claims 35-36, directed to the use of compounds according to the above-proposed defined group in the treatment of various diseases should be regarded as being

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unitary to the proposed product claim and, thus, should also be maintained in the present application.

In view of the above, reconsideration and further examination is requested.

If there are any fees due in connection with the filing of this election and response, please charge the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,



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